III. REMARKS

Claims 1-4 and 7-8 were rejected under 35 U.S.C. 103 as being unpatentable over Ejzak (US 6,721, 565) in view of Lautenschlager (US 6,321,096), and Claims 5-6 and 9-14 were rejected under 35 U.S.C. 103 as being unpatentable over Ejzak in view of Lautenschlager and Forslow (US 2003/0039237) for reasons set forth in the Office Action.

The following argument is presented to overcome the foregoing rejections, and to show the presence of allowable subject matter in the claims.

The new independent claims 16 to 19 cover the embodiment of short messages (e.g, supported in original claims 5 and 12).

The present invention is directed to a problem in systems having both packet-switched networks that support a transferring of messages, for instance GPRS networks supporting transfer of SMS short messages, and other packet-switched networks that do not support a transferring of such messages. In these situations the terminal (mobile station) does not know if the currently visited packet-switched network supports the transfer of such messages. The present invention provides for a selection and message transfer procedure that enables transmission of messages, which are intended to be transmitted to a packet-switched network, also to be transmitted in systems that do not support short message transmission via a packet-switched network (present specification on page 3 at lines 8-15).

As regards the present Office Action, the Examiner acknowledges that Ejzak does not disclose checking of attachment to the second network and transmission of message to the second network (middle of page 3 of the Office Action).

There are further differences between the present independent claims and Ejzak.

The teaching of Ejzak relates to the switching of an active cell to another network, i.e. a handover, and is not relevant to a teaching of the presently claimed features related to transmitting a message or performed in response to a need to transmit a message. Ejzak discusses handover of a continuous call. No actions even similar to the presently claimed ones are disclosed as triggered in response to a need to transmit a message. Instead, the referred handover actions are initiated in response to a need to transmit a message. Also, the referred handover actions are initiated in response to a situation of the current RF path being of poor quality. Since a handover by definition is only performed for an ongoing call, a call must be active in order for the handover procedures to occur (see also col. 14, lines 18-29 of Ejzak et al).

Further, the cited description on handover features does not anticipate the present features of checking an attachment to a packet-switched network (in response to a need to transmit a message), or further features based on this checking (... in response to the mobile station being attached to the second network). The fact that an adequate RF path is needed in order for the terminal and base station to communicate does not suggest a specific step of a checking of attachment to a packet-switched network.

Further, Ejzak fails to disclose the currently claimed feature of transmitting the message to a circuit-switched network in response to a failure in transmitting the message via the packet-switched network. The cited portions of Ejzak merely disclose a handover from a packet-switched network to a circuit-switched network as a response to detecting a need for such a handover. This determination is described in column 11, lines 31 – 50. The handover is initiated in response to a current RF path being of poor quality, this being detected based on channel measurements. There is no suggestion of detecting a failure of transmission of a message in the present claim context (e.g. based on a received error message from the network), and no suggestion of further actions, in particular of transmission of the message to a circuit-

switched network in response to such failure, i.e. after an unsuccessful attempt to transmit the message first via the first packet-switched network.

The Examiner combines Lautenschlager with Ejzak to provide disclosure of material not discussed by Ejzak, and notes that Lautenschlager discloses the situation of a handover between a public telephone network and a mobile network. However, there is no motivation to combine these references because an attempted combination does not suggest or lead to the present invention and, furthermore, these two references deal with different aspects of a communication system. Even if Lautenschlager is combined with Ejzak, the combination of these two teachings would fall to show or suggest the current combination of features in the present independent claims. Lautenschlager deals with establishment of a switching of network-side routing of future incoming calls to a mobile terminal and, therefore, would not be considered for an attempted solution to solve a problem or to enhance functionality related to message transmission from a terminal.

In support of Applicant's contention that there is no motivation to combine the teachings of Ejzak and Lautenschlager, it is observed that the choice of network to carry a terminal's communication is based on two different criteria. In the case of Ejzak, the intent is to provide communication via the second network having the packet communication capability, independently of the relative signal strength of the two networks, as long as there is sufficient signal strength to maintain communication via the second network. In Lautenschlager, the intent is to employ whichever network has the higher signal strength. Since the systems of these two references operate with different philosophies of operation, an artisan in the communication field would avoid any attempted combination of their teachings, this negating any motivation for combination of the two teachings.

Lautenschlager discloses a switchover method between two different wireless networks, in particular between a GSM network and a DECT network for a mobile

terminal moving between these networks. The mobile terminal is configured to initiate a switchover to another type of these networks if the terminal has moved to an area of another network. This is detected on the basis of the field strength of a selected radio network base station falling below a minimum value (column 5, lines 12-20).

The combination of these two references fails to disclose the checking of the attachment to the packet-switched network. The cited RF measurements taught both by Ejzak and Lautenschlager are for completely different purpose, namely for determining if handover or switch-over is necessary to maintain a high quality of transmission. Further, there is no indication towards arranging such check in response to a need to transmit a type of message. Instead, such measurements are typically periodically performed. Further, the features of Lautenschlager focus on arranging switching routing of future incoming calls to a mobile terminal (col. 4, lines 62-64). Hence, a man skilled in the art could not arrive at this claimed feature on the basis of the cited documents.

Further, the combination of the two references would fail to teach the limitation of specifically transferring a message to a circuit-switched network, and in response to a failure in transmitting the message via the packet-switched network. Lautenschlager merely teaches that, in response to moving out of range of a base station, there is a switching of routing in network-side for calls targeted to the mobile terminal (e.g. col. 6, lines 34-37). Thus, Lautenschlager is not relevant as regards the presently claimed features related to arranging transmission of a message by a mobile station. Further, the features (col. 8, lines 9-11) in a home location register (HLR) of a mobile communications core network causing network-side changes to (mobile-terminated) call routing are not relevant as regards the presently claimed features. Thus, there would be no motivation to combine Ejzak with Lautenschlager.

Hence, even if a man skilled in the art hypothetically would consider Lautenschlager in an attempt to improve Ejzak, Lautenschlager would not provide any substantial

additional teaching as regards the above-indicated differences between the current independent claims and the disclosure of Ejzak. Also, arguments presented in the previous response are believed still to be valid.

For all of the foregoing reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for the four extra independent claims ($800) as well as any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

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I hereby certify that this correspondence is being transmitted electronically, on the date indicated below, addressed to the Mail Stop AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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